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**IN THE
SUPREME COURT OF THE UNITED STATES.**

OCTOBER TERM, 1941.

EXHIBIT SUPPLY COMPANY,
Petitioner,
vs. } No. 154.

ACE PATENTS CORPORATION,
Respondent. }

GENCO, INC.,
Petitioner,
vs. } No. 155.

ACE PATENTS CORPORATION,
Respondent. }

CHICAGO COIN MACHINE COMPANY,
Petitioner,
vs. } No. 156.

ACE PATENTS CORPORATION,
Respondent. }

BRIEF FOR PETITIONERS.

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BRIEF FOR PETITIONERS.

To the Honorable the Chief Justice of the United States
and the Associate Justices of the Supreme Court of
the United States;

These patent infringement suits are here on Writs of
Certiorari to the Seventh Circuit Court of Appeals.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court, holding validity and
infringement, is reported in 45 U. S. Patent Quarterly 601
(R. 485).

The opinion of the Circuit Court of Appeals, which affirmed the District Court, is reported in 119 F. (2d) 349 (R. 670).

JURISDICTION.

The date of the judgments to be reviewed is March 12, 1941; rehearing denied May 16, 1941.

The Writs of Certiorari were granted by this Court on November 10, 1941.

The jurisdiction of this Court is invoked under Judicial Code, Section 240 (a), 28 U. S. C. A. 347, as amended by the Act of February 13, 1935.

STATEMENT OF THE CASE.

Respondent brought separate patent infringement suits upon the Nelson patent No. 2,109,678 against the three Petitioners. The cases were consolidated for trial, as well as on appeal. The patent in suit relates to a switch for use in ball rolling games (commonly called "pin ball machines"). Such switches are actuated to close an electrical circuit upon being contacted by a moving object, such as a ball rolling on a table.

The switch disclosed in the patent in suit is, in essence, like the prior Bolo device, Exhibit 35 (R. 469), differing therefrom in the location of parts. In each the switch includes a support attached to the table, a coil spring associated therewith and adapted to be flexed when a ball hits the target. The spring is electrically connected with a depending leg or extension* which, upon flexure of the spring, engages a stationary conductor to close an electric circuit. In the Bolo device, the stationary conductor took the form of a hole in a metal plate carried by the underside of the table. In the Nelson patent in suit, the stationary conductor took the form of a metal ferrule, embedded in

*In the accused devices there is no depending leg or extension.

the table.** While Nelson's spring is located above, and the Bolo spring below, the table, both do the same thing in the same way; that is to say, in each the spring flexes to close a circuit and, upon reflexing, causes rebounding of the ball upon the table.

In view of the prior art, the claims of the Nelson application, as filed, were each limited to details of construction.

On February 27, 1937 (after the Nelson application was filed), one of Petitioners publicly marketed and advertised (Exhibit 23, R. 357) a device (exemplified by Exhibit 5) of different construction from that disclosed in the application. It differs from the device disclosed in the patent in suit essentially in that the spring has no leg, and the stationary conductor is not a ferrule embedded in the table, but is a nail driven into the table. In that intervening device the lower end of the coil spring **terminated at a distance above the top surface of the table.**

No claim of Nelson's application, as filed, covered the intervening device.

The application, as originally filed, met with rejection (R. 443). Certain of the claims (not here in suit) were amended on June 12, 1937 (R. 444-5), and subsequently allowed (R. 449). At the same time (R. 445) Nelson added a new claim (numbered 7), which, as later amended, became the single claim here in suit. Unlike the originally presented claims, and unlike the device shown by Nelson (but like Petitioner's intervening device), this new claim did not include the feature of a leg or extension on the spring, but, on the contrary, recited that the spring **terminated "at a distance above the top surface of the table."** Additionally, the new claim specified that the stationary

**In the devices held to infringe, the stationary conductor takes the form of a nail driven in the table (Exhibits 5 and 7) or of a pin carried by a plate resting on the top of the table (Exhibits 8 and 10) or of a collar suspended above the table by a bracket attached to the underside of the table (Exhibits 3 and 9).

conductor should be **"carried by the table"**—and engageable by a portion of the spring.

This new claim was rejected as failing to comply with Section 4888 of the Revised Statutes (R. 449-50), the Examiner saying:

"It is old in the art to make an electrical contact by flexing a coil spring as shown by the art already cited in the case. In order to distinguish over the references therefor, the applicant's particular type of contact structure, comprising an **extension on the coil spring** adapted to engage an annular contact **embedded in the table**, must appear in the claims. Such structure is absent from the above rejected claims 2 and 7."

Thereupon, the new claim was amended to limit it to a structure wherein the stationary conductor was **"embedded in the table"** rather than being merely **"carried by"** the table (R. 450). In the informal remarks which accompanied this amendment, Nelson admitted to the Patent Office that he was attempting to cover a structure like Petitioner's intervening device, (Exh. 5, R. 51, and Exh. 7, R. 15), saying:

"Each of the allowed claims can, it seems, be very simply avoided by taking the leg 19, separating it from the spring 18 and embedding it as a pin in the table so that the spring when flexed would contact the pin" (R. 450, 451).

The claim still met with rejection, the Examiner saying:

"These claims call for a pendantsly mounted coil spring terminating at a distance above the top surface of the table and having a portion thereof engaging a conductor embedded in the table. With the type of conductor disclosed, such a structure would be inoperative as the coil spring could not both terminate at a distance above the table and extend into a ferrule embedded therein. It is true as the applicant sug-

*Emphasis supplied throughout unless otherwise indicated.

gested that if the portion 19 were removed from the spring and embedded in the table an operative device would result but **no such structure has been brought out by the drawing or specification**" (R. 452).

Thereupon the claim was further amended to cancel the provision that the coil spring should terminate "at a distance above the top surface of the table" (R. 453), and, as thus amended, the claim was allowed.

Decisions of the Courts Below.

The District Court held (R. 485) the patent valid and infringed, not only by the above mentioned intervening device (Exhibit 5) and one like it (Exhibit 7), but also by other and more remote devices, in which the stationary conductor was mounted in a separate plate (Exhibits 6 and 10) or took the form of a collar embracing the spring support and positioned above the table top (Exhibits 8 and 9). In all of the accused devices electric contact between the spring and the stationary conductor is made well above the top surface of the table, as distinguished from being made at or near the bottom surface of the table, as in the Nelson device.

The District Court accorded the patent in suit a wide range of equivalents and held infringement, notwithstanding that the claim in suit did not read upon the accused devices. By holding infringement, the lower Court enlarged the claim back to its preamended scope.

The District Court refused, in its decision, to limit the scope of the patent in suit in view of its file wrapper history.

The Circuit Court of Appeals affirmed the District Court, holding that the amendment of the claim in suit did not exclude Exhibits 5 and 7, and that Exhibits 6, 8, 9 and 10, although not covered by the claim, infringed because they were mechanically equivalent structures.

SPECIFICATION OF THE ASSIGNED ERRORS TO BE URGED.

1. That the Circuit Court of Appeals erred in allowing an informal remark about Petitioner's structure (not originally described or claimed) to deprive a limiting amendment of its effect as a file wrapper estoppel.

2. That the Circuit Court of Appeals erred in applying the doctrine of mechanical equivalents to enlarge the monopoly of the patent in suit beyond anything described or claimed in the original application.

3. That the Circuit Court of Appeals erred in failing to hold that Respondent was estopped by the file wrapper history from contending that Petitioner's device (which was informally mentioned to the Patent Office and ruled out) is within the scope of the claim in suit.

4. That the Circuit Court of Appeals erred in affirming and in not reversing the judgment of the District Court.

SUMMARY OF ARGUMENT.

A summary of Petitioners' Argument appears in the captions of the two points, which are set forth in the "Argument." It is not thought feasible to expand the summary beyond these captions without unduly lengthening this brief and resorting to very considerable repetition.

ARGUMENT.

The Petition for the Writs questioned the doctrine of mechanical equivalents and presented an issue of file wrapper estoppel. It was one of Petitioners' contentions in the courts below that the patent in suit is invalid because the subject matter failed patentably to distinguish from the prior art, and while we assume this court will not deal directly with that issue, brief reference to the prior art, as a referent, is essential to a consideration of the points presented. Otherwise, application of the doctrine of mechanical equivalents to extend the monopoly beyond the express terms of the claim, or disregard of file wrapper estoppel, may lead to a patent of such scope as to be invalid over the prior art. Indeed, the court below fell into that error. Notwithstanding the prior Fisher patent (R. 552) and the Bolo device (R. 469), and notwithstanding that the claim in suit was allowed only after the Examiner had required that, in order to distinguish over the prior art:

“... the applicant's particular type of contact structure, comprising an extension on the coil spring adapted to engage an annular contact embedded in the table, must appear in the claims” (R. 449-450),

the courts below proceeded to hold infringement by devices which (like the prior art) had neither the extension on the coil spring nor the annular contact embedded in the table. The patent could not, at once, be both valid and infringed.

POINT I.

The Doctrine of Mechanical Equivalents Is Incompatible With the Doctrine That the Patent Claim Measures the Invention; and Enlargement of a Patent Monopoly to Embrace Mechanical Equivalents, Not Within the Plain Terms of the Claim, Is a Relaxation of the Statutory Requirements.

- As we have shown above, the Circuit Court of Appeals,
- although recognizing that neither of Exhibits 6, 8, 9 or 10
 - was embraced by the terms of the claim in suit, held the same to be infringements of the patent because, it was supposed, that these devices were the mechanical equivalent of the device shown in the patent in suit. Thus, in connection with Exhibits 6 and 10, the Circuit Court of Appeals (R. 678) acknowledges that these devices do not have a conductor embedded in the table, but, rather, that a large hole is cut in the pin table and this hole is covered with a metal plate in which the stationary conductor is mounted; while anent Exhibits 8 and 9 the court recognizes that the stationary conductor (in the form of a collar) is not embedded in the table, but, rather, is mounted upon the top surface of the table on an insulating core, which is attached to the table by means of the spring-supporting standard (R. 678).

The fact that the patent claim in suit does not by its terms embrace structures such as Exhibits 6, 8, 9 and 10 raises the question of whether the scope of a patent is limited by the terms of its claims, or may be enlarged therebeyond by the so-called doctrine of mechanical equivalents.

The question of what is an infringement of a patent has been approached from two different angles by the courts. This Court has affirmatively held that the terms of the claims of a patent define the limits of the monopoly. Per-

mutit v. Graver, 284 U. S. 52, 60; Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278, 24 L. Ed. 344; Yale Lock Co. v. Greenleaf, 117 U. S. 554, 559, 6 S. Ct. 846, 29 L. Ed. 952; White v. Dunbar, 119 U. S. 47, 52, 7 S. Ct. 72, 30 L. Ed. 303; McClain v. Ortmyer, 141 U. S. 419, 424, 12 S. Ct. 76, 35 L. Ed. 800; Minerals Separation v. Butte etc. Co., 250 U. S. 336, 350, 39 S. Ct. 496, 63 L. Ed. 1019.

In another line of cases, however, this Court has held that where an accused device is the mechanical equivalent of the device disclosed in a patent, infringement exists, notwithstanding the verbal limitations of the claim. Winans v. Denmead, 15 How. 330, 343, 14 L. Ed. 717; Blake v. Robertson, 94 U. S. 728, 24 L. Ed. 245; Clough v. Barker, 106 U. S. 166, 1 S. Ct. 188, 27 L. Ed. 134; Royer v. Schultz Belting Co., 135 U. S. 319, 10 S. Ct. 833, 34 L. Ed. 214; Hoyt v. Horne, 145 U. S. 302, 12 S. Ct. 922, 36 L. Ed. 713.

These two approaches to the question of infringement are patently inconsistent. The inconsistency of the so-called doctrine of mechanical equivalents with the principle that a patent disclosure is open to the public, save as the claim forbids, was emphatically pointed out, at the inception of the so-called doctrine of mechanical equivalents, by Mr. Justice Campbell in his dissenting opinion in Winans v. Denmead, 56 U. S. 330:

"The patentee, not exaggerating the theoretical superiority of the form of his car, overlooked those facts which reduced its practical value to the level of cars of a form widely variant from his own. The object of this suit is to repair that defect of observation. It is, that this court shall extend, by construction, the scope of operation of his patent, to embrace every form which in practice will yield a result substantially equal or approximate to his own." 1 c. 346.

"* * * The patentee is obliged by law, to describe his invention, in such full, clear and exact terms, that

from the description, the invention may be constructed and used. Its principle and modes of operation must be explained; and the inventor shall particularly 'specify and point' out what he claims as his invention. Fullness, clearness, exactness, preciseness and particularity, in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfill the demands of Congress or the wants of the country. Nothing, in the administration of this law, will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of Congress. In my judgment, the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import."

Consequently, one considering any question of infringement must choose whether he is to follow the principle that the disclosure of a patent is open to the public, save as the claim forbids, or whether he is to follow the principle that nothing is open to the public which is a mechanical equivalent of the thing disclosed in the patent, claim limitations to the contrary notwithstanding. This raises the practical difficulty which repeatedly confronts the Courts, patentees, industry and counsel, that one cannot safely utilize disclosures of a patent, though unforbidden by a claim, where there is any room for argument upon the question of mechanical equivalents. In practice, a case seldom arises where there is no room for debate as to mechanical equivalents. A button and a zipper may both be used to close a garment, so some might argue that they are mechanical equivalents. Consequently, it frequently happens that the doctrine of mechanical equivalents is

*The inconsistency has also been noted by other Courts: *Claude Neon Lights v. E. Machlett & Son*, 36 F. (2d) 574, C. C. A. 2; *Otis Elevator Co. v. Atlantic Elevator Co.*, 47 F. (2d) 545, C. C. A. 2; *Oates v. Camp*, 83 F. (2d) 111, C. C. A. 4; *Directplate Corp. v. Donaldson Lithographing Co.*, 51 F. (2d) 199, C. C. A. 6.

applied by the Courts in such manner that the patent, in effect, covers the result, rather than the means for accomplishing the result, although this Court has repeatedly held that no patent can cover a result (*General Electric Co. v. Wabash Appliance Co.*, 304 U. S. 364, 371; *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, and cases cited 256-8; *O'Reilly v. Morse*, 56 U. S. 62). This, too, was presaged by Mr. Justice Campbell in *Winans v. Denmead*, *supra*, when, criticizing the majority opinion, he pointed out (l. c. 346):

"* * * It is, that this court shall extend, by construction, the scope of operation of his patent, to embrace every form which in practice will yield a result substantially equal or approximate to his own."

The Patent Statutes (R. S. 4888, 35 U. S. Code 33) require patentees to "particularly point out and distinctly claim the part, improvement or combination" which the patent is supposed to cover. The purpose of this is pointed out by this Court in *White v. Dunbar*, 119 U. S. 47, as follows (l. c. 52):

"* * * The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

As more recently stated by this Court, *Schriber-Schroth v. The Cleveland Trust Co.*, 305 U. S. 47 (l. c. 57):

"The object of the statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' *Permutit Co. v. Graver Corp.*, 284 U. S. 52, 60",

and in *General Electric v. Wabash Appliance Co.*, 304 U. S. 364, 1 c. 369:

“ * * * Congress requires of the applicant ‘a distinct and specific statement of what he claims to be new, and to be his invention.’ Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from **uncertainty** as to their rights. The inventor must ‘inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.’ The claims ‘measure the invention.’ ”

Despite this statutory requirement, the various courts, including the Courts below, have applied the so-called doctrine of mechanical equivalents to enlarge the scope of patents, including the patent in suit, beyond the plain terms of the claims. This defeats the purpose of the claim, and the claim becomes a vain, unnecessary, and misleading thing.

Abolition of the doctrine of mechanical equivalents would harm no one except overreaching patentees who seek to stretch their issued patents to dominate things not comprehended at the time of filing their applications, and not contemplated by the Patent Office when the claim was

*In such cases the courts, in practical effect, rewrite the claims of the patent, as Judge Learned Hand said:

“ * * * in misericordiam to relieve those who have failed to express their complete meaning ” (*Claude Neon Lights v. E. Machlett & Son*, supra, 1 c. 576).

allowed. Full opportunity is afforded inventors, in the Patent Office, to claim their inventions broadly or narrowly. Since a patentee has full opportunity to claim his invention broadly, he is entitled to no special consideration because of his failure to do so. The spirit of the patent laws demands that a patentee shall be bound by the claims as agreed upon by the Patent Office. Any relaxation of the statutory requirements such as by resort to the so-called doctrine of mechanical equivalents is "productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands" (Winans v. Denmead, *supra*, dissenting opinion of Mr. Justice Campbell, l. c. 347).

That the doctrine of mechanical equivalents may have a proper place as a limitation upon the apparent scope of a patent claim is by no means inconsistent with our contention that it has become a subterfuge whereby a patentee may enlarge his monopoly, and, hence, recapture a thing which, on the face of the patent, became open to the public. The doctrine of mechanical equivalents as a means for voiding express limitations in the claims of a patent should be abolished.

If, as we contend, nothing is an infringement unless it is embraced by the claim, neither of Petitioner's Exhibits 6, 8, 9, or 10 can infringe, because in none of them is there a conductor "embedded in the table" as prescribed by the claim here in suit.

POINT -II-

When, during the Pendency of an Application, the Applicant presents a Claim Calculated to Cover an Alternative Structure not disclosed in the Original Application but being then Commercialized by Another, the Patent Office Rules That the Alternative Structure is not Brought Out by the Specification or Drawings, the Ruling is acquiesced in, the Claim Amended to Conform it to the Specification and Drawings, and as thus Amended, Allowed—the Patentee is Estopped to Contend that the Amended and Allowed Claim Covers the Intervening Structure Sought to be Covered by the Rejected and Surrendered Claim (Qs. 2 and 3, p. 4, Petition).

As we have shown hereinbefore, the Nelson application, as filed, contained no claim which would read upon any of the Petitioners' devices; it disclosed but one form, and contained no hint at the alternative structures represented by any one of Petitioners' six found-infringing devices (Exhibits 5, 6, 7, 8, 9, 10). Not until after one of Petitioners had marketed the Exhibit 5 device did Nelson attempt to enlarge the monopoly sought. Prosecution of Nelson's Application reflects that the Patent Office was unwilling to allow claims of scope such as to cover Exhibits 6, 8, 9 and 10, and was unwilling to allow claims addressed to the specific structure of Exhibits 5 and 7 (suggested as an alternative in the informal Remarks of an amendment).

Estoppel by File Wrapper History.

When first presented to the Patent Office (after Petitioners' intervening device was on the market) the claim here in suit read:

"In a ball rolling game having a substantially horizontal table over which balls are rollable, the com-

bination with said table of a substantially vertical standard anchored in said table with its lower end carrying on the underside of the table a lead for an electric circuit and its upper end extending a substantial distance above the top surface of the table, a coil spring surrounding the standard, means carrying said spring pendantsly from the upper portion of the standard with the coils of the spring spaced from the standard and the lower end of the coil spring terminating at a distance above the top surface of the table to enable the spring to be resiliently flexed when bumped by a ball rolling on the table, said spring being in the aforementioned circuit and constituting a conductor, and other conductor means carried by the table at a point spaced from the standard and engageable by a portion of the spring when it is flexed to close the aforementioned circuit" (emphasis ours).

Had the claim been allowed in that condition, it would have read upon all of Petitioners' devices. But it was not allowed. It was rejected. Subsequently it was amended to change the definition of the relation of the conductor to the table from:

"carried by the table"

to:

"embedded in the table" (R. 450).

As the Circuit Court of Appeals said (R. 678):

"Prior to this substitution of language almost any form of conductor which was mounted on the table in any place or manner, permanently or movable, would have answered the language of the claim,"

but the Court of Appeals failed to recognize that when Nelson thus definitely defined and claimed the conductor as being "embedded in the table," he forever disclaimed any and all devices in which the conductor was merely "carried by the table."

Under such circumstances, to hold infringement by devices like Exhibits 6, 8, 9 and 10,* which indisputably do not have the conductor embedded in the table, does violence to two settled rules of estoppel by file wrapper history:

First, the patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without amendments, required as a condition precedent to allowance. As held by this Court in *Weber Electric Co. v. Freeman Electric Co.*, 256 U. S. 668, l. c. 677-8:

“* * * Having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without amendments, which amount to a disclaimer of rotation as an operative feature of his device. *Shepard v. Carrigan*, 116 U. S. 593, 598; *Hubbell v. United States*, 179 U. S. 77, 80.”

See, also, *Smith v. Magic City Club*, 282 U. S. 784, 790; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 444; *Schriber-Schroth v. Cleveland Trust Co. et al.*, 311 U. S. 211.

Second, that an amendment to a claim, after rejection thereof, is to be strictly construed against the inventor and in favor of the public and looked upon as in the nature of a disclaimer. In *Smith v. Magic City Kennel Club*, 282 U. S. 784, l. c. 790, this Court held:

*And we think also Exhibits 5 and 7, but we pass this contention in their regard, as such would involve a factual controversy as to whether a nail driven into a table is a “conductor embedded in the table” in the sense of the Nelson patent. As to these two Exhibits, we submit that further estoppel results from the fact that Nelson attempted to and the Patent Office prohibited him from presenting a claim which would read upon these two Exhibits, upon the ground (R. 452) that

“* * * no such structure has been brought out by the drawing or specification.”

“ * * * The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent v. Hall Safe & Lock Co.*, 114 U. S. 63, 86; *Shepard v. Carrigan*, supra, 598; *Hubbell v. United States*, supra, 85.”

See, also, *Snow v. Lake Shore & M. S. Ry. Co.*, 212 U. S. 617, 630, cited with approval *Schriber-Schroth v. Cleveland Trust*, 305 U. S. 47, l. c. 57; *Schriber-Schroth v. Cleveland Trust et al.*, 311 U. S. 211; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405; *Keystone Bridge Company v. Phoenix Iron Company*, 95 U. S. 274.

The File Wrapper History Shows the Attempt to Dominate the Intervening Device.

As noted above, the claim in suit was presented to the Patent Office after Petitioners' intervening device, Exhibit 5, was on the market. As presented, it called for a structure (unlike that disclosed but like the intervening device) in which the coil spring had its lower end “terminating at a distance above the top surface of the table.”

In the informal remarks accompanying the amendment whereby the claim in suit was changed from defining the conductor as “carried by the table” to “embedded in the table,” Nelson's solicitor urged the allowance of the claim addressed to the alternative structure, exemplified by petitioner's intervening device, because (R. 450):

“Each of the allowed claims can, it seems, be very simply avoided by taking the leg 19, separating it from the spring 18 and embedding it as a pin in the table, so that the spring when flexed would contact the pin.”

Although the Patent Office had no way of knowing that Petitioners' intervening device had inspired this afterthought, the Examiner rejected the claim, saying (Rec. 452):

"Claim 7 and claim 8 which was previously thought to be allowable, are both rejected as describing an inoperative structure in view of the applicant's disclosure.

"These claims call for a pendantly mounted coil spring terminating at a distance above the top surface of the table and having a portion thereof engaging a conductor embedded in the table. With the type of conductor disclosed, such a structure would be inoperative as the coil spring could not both terminate at a distance above the table and extend into a ferrule embedded therein. It is true as the applicant suggested that if the portion 19 were removed from the spring and embedded in the table an operative device would result but no such structure has been brought out by the drawing or specification."

Thereupon the claim was further amended to cancel the previously recited feature that the spring had its lower end "terminating at a distance above the top surface of the table."

Nelson therefore attempted to specifically claim a thing which was not disclosed by his application. Upon meeting with rejection, he abandoned the attempt. The ruling of the Courts below that the thing which Nelson thus sought to specifically claim is an infringement, is clearly in conflict with the decision of this Court in *Schriber-Schroth v. The Cleveland Trust Company*, 305 U. S. 47, 1. c. 57:

"• • • It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires, *Permutit Co. v. Graver Corporation*, *supra*, at 57; that it cannot be enlarged

by claims in the patent not supported by the description, *Snow v. Lake Shore & M. S. Ry. Co.*, 121 U. S. 617; cf. *Smith v. Snow*, 294 U. S. 1; and that the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, **at least when adverse rights of the public have intervened.** *Railway Co. v. Sayles*, 97 U. S. 554, 563, 564; *Powers-Kennedy Corp. v. Concrete Co.*, 282 U. S. 175, 185-186; cf. *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463; *Permutit Co. v. Graver Corporation*, *supra*; *Crown Cork & Seal Co. v. Gutmann Co.*, 304 U. S. 159."

Assuming *arguendo* that the nail in the table of Exhibits 5 and 7 is a "conductor embedded in the table" in the sense of the Nelson patent, the Court of Appeals erred in enforcing the Nelson patent against such devices.

The Court of Appeals apparently treated the informal remark, anent structures like Petitioners' intervening device, as if it were a suggestion contained in Nelson's original application, because the Court of Appeals took note of this in making its determination of infringement. It is settled, of course, that if such a suggestion had been, by amendment, written into the descriptive part of the Specification, the patent would have been invalid (*Mackay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U. S. 86, l. c. 100 and 101; *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175; *Automatic Devices Corporation v. Sinko Tool & Mfg. Co.*, 112 F. (2d) 332, and compare *Sontag Chain Stores Co. v. National Nut Co. of California*, 310 U. S. 281).

Instead of regarding the attempt of Nelson to dominate the intervening rights of Petitioners "with jealousy and disfavor" (*Railway Co. v. Sayles*, 97 U. S. 554), and notwithstanding that the Court below has held that a change of a patent specification to embrace an intervening device

invalidates the patent, the Court of Appeals regarded this informal remark as a virtue having all of the good attributes which it might have had if it had been a part of the original application, without any of the evils it would have had if made as a formal amendment.

Under the circumstances, the attempt to dominate the intervening device should "destroy the patent" as in Powers-Kennedy Corporation v. Concrete Mixing & Conveying Co., supra.

CONCLUSION.

As we have pointed out, infringement cannot be held without stretching the claim beyond its plain terms by application of the doctrine of mechanical equivalents. While we think the file wrapper estoppel precludes such enlargement of the claim, it is noteworthy that even if the file wrapper estoppel were absent, enlargement of the claim to embrace all mechanical equivalents would invalidate it in view of the prior Bolo device. The Court below erroneously considered the Nelson patent narrow for one purpose (validity) and broad for another (infringement).*

Judgment of the Seventh Circuit Court of Appeals, we submit, should be reversed and the cause remanded to the District Court for the Northern District of Illinois, Eastern Division, with instructions to dismiss the complaint.

Respectfully submitted,

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*In Mackay Company v. Radio Corporation, 306 U. S. 86, this Court pointed out that a patentee,

"... avoiding prior art by defining his (improvement) with mathematical precision, cannot discard that precision to establish infringement" (l. c. 102).